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NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			EXAMINER MEHRA, INDER P	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 06/25/2004 11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/308,114

Applicant(s)

SAWADA, AKEMI

Examiner

Inder P Mehra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Response to Amendment

1. This is in response to an amendment B dated 9/8/03 which has been fully considered and made of record. Based on this amendment, claims 12 and 22 have been amended. Claims 1-11 were cancelled in Amendment A dated 1.6.03. Claims 12-22 are now pending.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate "communication terminals", refer to specification page 4 lines 1, 3, 5-6, subscriber lines 11, refer to specification page 4 line 13 and "subscriber device", refer to claim 12 and line 17. Applicant argued that "common terminal" is "common terminal point", and argued that specification at page 9 describe the subscriber device sufficiently to one of even ordinary skill in the field. This argument is not persuasive. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate both communication device, specification page 4 lines 1, 3 and 5-6, subscriber lines 11, refer to specification page 4 line 13 and subscriber device, refer to claim 12 and line 17.

Applicant argues, "reference character 11 is not used to designate subscriber device anywhere in the application" and further, that reference character 11 is not used in line 17 of claim 12 or any other claim".

In response, it is stated that reference character, as specified in specification at page 4 lines 1, 3, 5-6 and 20, is to designate 'communication terminal', which is disclosed in fig. 1, and

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is meant to be the subscriber device recited in claim 12 line 17. If not agreed, then subscriber device in claim 12 line 17 *is not supported by specifications*. Further, “subscriber lines” is designated by character 11 in line 13 of specification at page 4. Therefore, character 11 designates both “communication terminal”, refer to specification page 4 lines 1, 3, 5-6 and 20, “subscriber device” (claim 12 line 17) and “subscriber lines 11” at page 4 of specification at line 13.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 19 recites the limitation, “the service identification number” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Applicant argues that “the service identification number” did not lack antecedent basis since “a service identification number” was recited in claim 18, from which claim 19 depends”.

In response, it is stated that claim 19 *does not depend from claim 19, rather it depends from claim 12*.

Appropriate correction is required.

Specification

4. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood:

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a. Refer to specification page 9 line 18. The access server makes it possible for a subscriber device, which is connected with the subscriber switching system 14 not through the switch 15 but directly, to make an access to the LAN 16. In fig. 1, access is through the switch 15 and not directly. Appropriate correction/clarification is required is required.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant has amended specification to include "unlike the preferred embodiment described earlier and shown in fig. 1, the subscriber device in this instance is not connected with the subscriber switching system 14". This is a new matter, and also not supported by drawings.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Further, the access server, as disclosed in specification at page 9 lines 11, 18 and 22. is not disclosed in the drawings.

Appropriate correction /clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 12, 13, 15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by

Curry et al (US Patent No. 6,233,234), hereinafter Curry.

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For claim 12, Curry discloses, in reference to fig. 1, a communications system, refer to “telephony communication system”, refer to abstract, col. 1 lines 4-10, comprising:

- a subscriber switching system (PBX) provided at a subscriber switching station (10) for exchanging telephone calls (telephony link, col. 1 line 50 and abstract);
- a LAN (38, col. 13 lines 55-60)-----, the LAN not being directly connected to an internet (48), refer to fig. 6, the access gateway 66 comprises a LAN server and router 55 interfacing between the LAN and the Internet, refer to col. 18 lines 25-28;
- branching means, refer to col. 7 lines 59-65, col. 13 lines 49-65, provided at the subscriber switching station (10), ---having a common terminal point (trunks 14 and 16, col. 13 lines 49-51), a first branching terminal point (trunk 14 and 18 connected to central office 18, refer to col. 7 lines 59-65), and a second branching point (refer to “LAN 38 is connected to the respective PBXs, refer to col. 13 lines 55-60 and col. 14 lines 20-25), the common terminal point being connected with a subscriber line (trunks 14 and 16, col. 13 lines 49-51) at a side of the subscriber switching system (PBX), and the second branching terminal point connected with the LAN (LAN 38), the common terminal point and the first branching terminal point being used in combination for establishing a first path for conventional telephone communications (global telephony link, refer to col. 7 lines 50-52, col. 7 lines 59-65), and the common terminal point and the second branching terminal point being used in combination for establishing a second path for data communications transferred over the LAN (LAN 38), refer to col. 13 lines 55-64;

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- at least one information providing server connected to and associated with the LAN, fig. 6, for providing a subscriber device (30 A, 33B, 33C and 44A, 44B) with information through the LAN (LAN 38) and the subscriber line (trunks 14 and 16, col. 13 lines 49-65).

For claim 13, Curry discloses, “wherein the LAN connected with the at least one information providing server is placed together with the subscriber switching system in a corresponding switching station, refer to col. 2 lines 25-28, 46-47 and 60-67, fig. 6, col. 18 lines 26-34.

For claim 15, Curry discloses, “wherein the at least one information providing server comprises a mail server, refer to col. 11 lines 15, 20-25 and mail server 1209 in col. 11 line 44.

For claim 20, Curry discloses “**access point to the internet is connected with the LAN**”, refer to figs. 1 and 6.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Curry et al**, hereinafter, Curry, as in claim 12 above, in view of **Kahn et al** (US Patent No. 6,574,628), hereinafter Kahn.

Curry discloses all the limitations of the subject matter, as in claim 12 above, with the exception of the following limitation, which is disclosed by Kahn as follows:

- wherein the at least one information providing server comprises a document browsing server, refer to col. 20 lines 50-55.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the capability of document browsing server. The capability, as taught by Kahn, is combined with LAN,. The suggestion/motivation to do so would have been to provide "value-added service providers" that facilitate transfer of information.

7. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Curry et al**, hereinafter, Curry, as in claim 12 above, in view of **Lieu et al** (US Patent No. 6,349,096), hereinafter Lieu.

For claims 16-17, Curry discloses all the limitations of the subject matter, as in claim 12 above, with the exception of the following limitation, which is disclosed by Lieu, refer to fig. 3, col. 7 lines 17-22:

- **the call-out information --- generated in response to a call-out signal ---on the subscriber line, as recited by claim 16, col. 7 lines 17-22;**
- **branching means connects the subscriber line with the switching system ---- subscriber line, as recited by claim 17, refer to col. 7 lines 17-22.**

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Liu, in fig. 3, discloses a communications system comprising: **branching means (241), switching system means (242), information provider server (243)** with structure and functions as claimed. Besides, the branching means (241) separates signals based on **frequency bands**, and it is inherent that, for 2way communication, the branching means (241) connects the **subscriber line (225) with the switching system means (242) in response to a call-out signal sent from the switching system means to the subscriber line**, refer to col. 7 lines 17-22.

A person of ordinary skill in the art would have been motivated to employ Lieu's system into Curry's session management system in order to achieve switching system. The suggestion/motivation to do so would have been to have digital simultaneous transmission of voice and data on a single line. It would have been obvious to a person of ordinary skill in the art to transmit simultaneously to PSTN/ISDN (switching system) and Internet over the LAN.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Curry et al**, hereinafter, Curry, as in claim 12 above, in view of **MacNaughton et al**. (US Patent No. 5,796,393 A), hereinafter MacNaughton.

For claims 18 and 19, Curry discloses a communications system and limitations of the subject matter, as discussed in claim 12 above, with the exception of, " the subscriber line is connected with the information providing server based on a service identification number, *as recited by claim 18*; and an information providing server provided for each community is accessed by inputting the service identification number followed by a corresponding community identification code, as recited by claim 19.

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MacNaughton, in col. 9, lines 2-18, teaches that in a communications system having a plurality of **information servers** (local and foreign servers), when the user requests access to a community server, information such as **service ID number (community identification number)** and **community identification code (community text name)** need to be supplied to **establish a connection from the user to the community server.**

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to apply MacNaughton's teaching in Curry's system to reduce burden for routers in Curry and provide quick connections to the users. Web users need the ability form on-line relationships with others and communicate with others of similar interests or background.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Curry et al**, hereinafter, Curry, as in claim 12 above, in view of **Beyda et al** (US Patent No. 6,021,120), hereinafter Beyda.

For claim 21, Curry discloses all the limitations of subject matter with the exception of, "**the branching means separates signals based on frequency bands**";

Beyda discloses **separation of signals based on frequency bands**, refer to col. 3 lines 13-16;

A person of ordinary skill in the art would have been motivated to employ Beyda's system into Curry's session management system in order to achieve switching system. The suggestion /motivation to do so would have been to have transmission of voice and data on a single line. It would have been obvious to a person of ordinary skill in the art to split and route

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PSTN/ISDN (switching system) on one frequency and to Internet over the LAN on different (higher) frequency.

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Curry et al**, hereinafter, Curry, as in claim 12 above, in view of **Farris et al** (US Patent No. 6,721,306), hereinafter Farris.

For claim 22, Curry discloses, in reference to fig. 1, a communications system, refer to "telephony communication system", refer to abstract, col. 1 lines 4-10, comprising:

- a subscriber switching system (PBX) provided at a subscriber switching station (10) for exchanging telephone calls (telephony link, col. 1 line 50 and abstract);
- a LAN (38, col. 13 lines 55-60)-----, the LAN not being directly connected to an internet (48), refer to fig. 6, the access gateway 66 comprises a LAN server and router 55 interfacing between the LAN and the Internet, refer to col. 18 lines 25-28;
- branching means, refer to col. 7 lines 59-65, col. 13 lines 49-65, provided at the subscriber switching station (10), ----having a common terminal point (trunks 14 and 16, col. 13 lines 49-51), a first branching terminal point (trunk 14 and 18 connected to central office 18, refer to col. 7 lines 59-65), and a second branching point (refer to "LAN 38 is connected to the respective PBXs, refer to col. 13 lines 55-60 and col. 14 lines 20-25), the common terminal point being connected with a subscriber line (trunks 14 and 16, col. 13 lines 49-51) at a side of the subscriber switching system (PBX), and the second branching terminal point connected with the LAN (LAN 38), the common terminal point and the first branching terminal point being used in

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combination for establishing a first path for conventional telephone communications (global telephony link, refer to col. 7 lines 50-52, col. 7 lines 59-65), and the common terminal point and the second branching terminal point being used in combination for establishing a second path for data communications transferred over the LAN (LAN 38), refer to col. 13 lines 55-64;

- at least one information providing server connected to and associated with the LAN, fig. 6, for providing a subscriber device (30 A, 33B, 33C and 44A, 44B) with information through the LAN (LAN 38) and the subscriber line (trunks 14 and 16, col. 13 lines 49-65).

Curry does not disclose expressly mobile station and base station;

Farris discloses mobile station and base station, refer to abstract, col. 10 lines 1-3 and fig. 1.

A person of ordinary skill in the art would have been motivated to employ Farris's mobile system into Curry's system in order to achieve LAN associated with switching system. The suggestion/motivation to do so would have been to provide telephony communications through a packet switched data network such as Internet and an organization having telephone and computer connected to LAN in wireless environments. It would have been obvious to a person of ordinary skill in the art to transport calls to and from localized wireless systems via telephone carrier network.

Response to Arguments

11. Applicant's arguments with respect to claims 12-22 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

12. Any enquiry concerning this communication should be directed to Inder Mehra whose telephone number is (703) 305-1985. The examiner can be normally reached on Monday through Friday from 8:30AM to 5:00 PM.

If attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Seema Rao , can be reached on (703) 308-5463. Any enquiry of a general nature of relating to the status of this application or processing should be directed to the group receptionist whose telephone number is (703) 305-4700.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to (703) 872-9314.

Hand -delivered responses should be brought to Crystal Park II, 2121 Crystal drive,
Arlington, VA, sixth floor (Receptionist).

Inder Mehra
Inder Mehra

June 14, 2004


DANGTON
TIMOTHY DANGTON